



7744
AF #


PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dean R. Brown	Examiner: D. Fidei
Serial No. 10/090,885	Group Art Unit: 3728
Filed: March 4, 2002	
For: CONTAINER WHOSE SIDE WALL INCLUDES A SURFACE DISCONTINUITY TO HOLD SHRINKWRAP THERETO	Docket No. PWP0002/US/2

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I CERTIFY THAT ON MARCH 15, 2005, THIS PAPER IS BEING
DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS
MAIL IN AN ENVELOPE ADDRESSED TO MAIL STOP APPEAL
BRIEF-PATENTS, COMMISSIONER FOR PATENTS, P.O. BOX 1450,
ALEXANDRIA, VA 22313-1450


RENEE A. WOLFF

APPEAL BRIEF

Dear Sir or Madam:

This Appeal Brief is being submitted in support of an Appeal from the Final Rejection mailed May 11, 2004, in connection with the above-identified patent application. Enclosed is a fee in the amount of \$500.00 for filing the Appeal Brief.

A Notice of Appeal was timely submitted on November 12, 2004, which according to PAIR, was received in the Patent Office on November 15, 2004. Two-months from actual receipt of the Notice of Appeal is January 15, 2005. Applicant respectfully petitions the Commissioner for Patents to extend the time-period for response for two months from January 15, 2005, to March 15, 2005. A fee of \$450.00 is enclosed herewith for the two-month extension.

It is believed that no other fee is required in connection with the filing of this Appeal Brief. Should any additional fee be required, the Commissioner is authorized to charge Kagan Binder Deposit Account No. 50-1775 and thereafter notify us of the same.

03/18/2005 MAHNE1 00000005 10090885

01 FC:1402
02 FC:1252

500.00 DP
450.00 DP

Table of Contents

	<u>Page</u>
I. Real Party in Interest	3
II. Related Appeals and Interferences	4
III. Status of Claims	5
IV. Status of Amendments	7
V. Summary of Claimed Subject Matter	8
VI. Grounds of Rejection to be Reviewed on Appeal	10
VII. Argument	12
VIII. Claims on Appeal Appendix	26
IX. Evidence Appendix	28
X. Related Proceedings Appendix	29

I. Real Party in Interest

PWP Industries, Inc. is the real party in interest.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of Claims

Claims 13-16 have been cancelled.

Claims 1-12 are pending in the application.

Claims 11 and 12 have been withdrawn from consideration.

Claims 1-10 stand rejected as follows:

Rejections in Final Office Action Mailed May 11, 2004

Claims 1, 2, 6, and 7 stand rejected under 35 U.S.C. §102(b), as being anticipated by Ando (U.S. Patent No. 3,976,795).

Claims 1, 2, and 6-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Karevaara (U.S. Patent No. 4,102,454).

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Marino, Jr. et al. (U.S. Patent No. 5,605,230) and over Ando in view of Karevaara, and further in view of Marino, Jr. et al.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ando in view of Gray, Jr. (U.S. Patent No. 5,489,126) and over Ando in view of Karevaara, and further in view of Gray, Jr.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ando in view of Kaufman (U.S. Patent No. 6,247,612) and over Ando in view of Karevaara, and further in view of Kaufman.

All these rejections of claims 1-10 in the Final Office Action are appealed.

Rejections in Non-Final Office Action Mailed October 10, 2003

Note: In response to the Non-Final Office Action mailed October 10, 2003, Applicant amended independent claim (claim 1) and presented arguments why the rejections in the Oct. 10th Office Action did not stand in light of the amendment. In the above-identified Final Office Action, the Examiner merely stated in response to Applicant's arguments that "the rejection has been maintained to the extent as is applicable in light of the new amendments to claim 1." Because of the vagueness of this statement, Applicant assumes for purposes of appeal that the rejections in the Non-Final Office Action, mailed October 10, 2003, have not been withdrawn. Those rejections are as follows:

Claims 1 and 8-10 stand rejected under 35 U.S.C. §102(e) as being anticipated over Rashid (U.S. Pub. No. 2001/0006165).

Claims 1, 2, and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated over Erlandson (U.S. Pat. No. 4,183,441).

Claims 1-3, 6, and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated over Marino, Jr. et al. (U.S. Pat. No. 5,605,230).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlandson as applied to claim 2 above, and further in view of Gray, Jr. (U.S. Pat. No. 5,489,126).

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Erlandson as applied to claim 2 above, and further in view of Fillwalk et al. (U.S. Pat. No. 3,235,112).

All these rejections of claims 1-10 in the above-mentioned Non-Final Office Action are appealed.

IV. Status of Amendments

Applicant attempted to amend claim 1 after Final Rejection. That amendment was not entered.

Claims 1-10 on appeal are as presented in the Response to Non-Final Office Action filed March 10, 2004. A listing of those claims can be seen in Section VIII.

V. Summary of Claimed Subject Matter

Note: In this Summary of Claim Subject Matter Section, the parenthetical citations refer to Applicant's patent application, as originally filed.

Claim 1 on appeal recites a container including the unique combination of features of 1) a side wall tapering from top to bottom, 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at least a portion of the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity.

Because the side wall tapers from top to bottom, the container can nest within one or more other containers (see, e.g., page 5, lines 22 and 23). Yet, the surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container helps hold shrinkwrap in position against the tapered side wall (see, e.g., page 6, lines 16-22). The presently claimed invention is unique because it provides a container with nesting capability via the tapered side wall structure, while also including a surface discontinuity disposed on the tapered side wall structure, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered side wall (see, e.g., page 5, lines 22 and 23 and page 6, lines 3, 4, and 16-22).

Providing a container that can nest with other containers is advantageous because, e.g., reduced space is often required for the containers during, e.g., storage and/or transportation prior to being filled with items and covered with a lid. Once the containers are filled, they can be wrapped with shrinkwrap to help secure the lid and/or to improve storage (see, e.g., page 1, lines 15-17 and page 6, lines 9-15). Securing the shrinkwrap to the container can be conventionally done by forming the shrinkwrap around the top and sidewall of the container (see, e.g., page 6, lines 9-13). However, a downside of conventional containers having a side wall that tapers from top to bottom is that if shrinkwrap is subsequently torn from the lid to gain access to the container, the shrinkwrap tends to fall from the side of the container (see, e.g., page 3, lines 25-27). Likewise, any labeling and/or designs attached to the shrinkwrap and/or positioned between the shrinkwrap and container sidewall without adhesive also fall from the side of

the container (see, e.g., page 3, line 22 to page 4, line 4, and page 8, line 23 to page 9, line 6).

However, Applicant's unique claimed combination overcomes this pitfall by providing a surface discontinuity disposed on the tapered side wall of a nestable container, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered side wall (see, e.g., page 2, lines 25-28, page 5, lines 22 and 23, and page 6, lines 3, 4, and 16-22). That is, if shrinkwrap is initially wrapped around the top of such a container and the shrinkwrap is subsequently torn from the top portion of the container, a surface discontinuity according to the present invention helps hold the shrinkwrap in position against the tapered side wall (see, e.g., page 6, lines 16-22).

Another advantage of a container according to Applicant's unique claimed combination is that if the shrinkwrap layer initially covers the entire lid after packaging, the excess or overhang portion of the shrinkwrap layer that has been repositioned to gain access inside the container can be replaced over the lid to help reseal the container after it has been initially opened (see, e.g., page 9, lines 7-17).

An exemplary embodiment of a container according to the presently claimed invention can be seen, e.g., in FIGS. 1-4. Container 30 includes sidewall 34 tapering from the top (near rim 36) towards bottom 32, such that container 30 can nest with another container 30, while also including a surface discontinuity 46 disposed on the tapered side wall 34, intermediate rim 36 and bottom 32 of container 30, that helps hold shrinkwrap layer 48 in position against the tapered side wall 34 (see, e.g., page 5, line 19 to page 6, line 22).

VI. Grounds of Rejection to be Reviewed on Appeal

Grounds of Rejection Presented in Final Office Action Mailed May 11, 2004

A. A first issue on appeal is whether claims 1, 2, 6, and 7 are novel under 35 U.S.C. §102(b) over Ando (U.S. Patent No. 3,976,795).

B. A second issue on appeal is whether claims 1, 2, and 6-10 are patentable under 35 U.S.C. §103(a) over Ando in view of Karevaara (U.S. Patent No. 4,102,454).

C. A third issue on appeal is whether claim 3 is patentable under 35 U.S.C. §103(a) over Ando in view of Marino, Jr. et al. (U.S. Patent No. 5,605,230) and over Ando in view of Karevaara, and further in view of Marino, Jr. et al.

D. A fourth issue on appeal is whether claim 4 is patentable under 35 U.S.C. §103(a) over Ando in view of Gray, Jr. (U.S. Patent No. 5,489,126) and over Ando in view of Karevaara, and further in view of Gray, Jr.

E. A fifth issue on appeal is whether claims 4 and 5 are patentable under 35 U.S.C. § 103(a) over Ando in view of Kaufman (U.S. Patent No. 6,247,612) and over Ando in view of Karevaara, and further in view of Kaufman.

Grounds of Rejection Presented in Non-Final Office Action Mailed October 10, 2003

See note above in Section III, Status of Claims.

F. A sixth issue on appeal is whether claims 1 and 8-10 are novel under 35 U.S.C. §102(e) over Rashid (U.S. Pub. No. 2001/0006165).

G. A seventh issue on appeal is whether claims 1, 2, and 6 are novel under 35 U.S.C. §102(b) over Erlandson (U.S. Pat. No. 4,183,441).

H. An eighth issue on appeal is whether claims 1-3, 6, and 7 are novel under 35 U.S.C. §102(b) over Marino, Jr. et al. (U.S. Pat. No. 5,605,230).

I. A ninth issue on appeal is whether claim 4 is patentable under 35 U.S.C. § 103(a) over Erlandson as applied to claim 2 above, and further in view of Gray, Jr. (U.S. Pat. No. 5,489,126).

J. A tenth issue on appeal is whether claim 5 is patentable under 35 U.S.C. § 103(a) over Erlandson as applied to claim 2 above, and further in view of Fillwalk et al. (U.S. Pat. No. 3,235,112).

VII. Argument

Note: The following terminology is use in this Argument section:

- “First O.A.” refers to the First Office Action mailed October 10, 2003; and
- “Final O.A.” refers to the second and Final Office Action mailed May 11, 2004.

A. Claims 1, 2, 6, and 7 are novel under 35 U.S.C. §102(b) over Ando.

Independent claim 1 recites a container having the combination of features, including, 1) a side wall tapering from top to bottom, 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at least a portion of the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity. As described above, this claimed combination is unique because the tapered sidewall allows the container to nest with one or more other like containers, yet has a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container that helps hold the layer of shrinkwrap in position against the tapered sidewall.

Such a container can be highly advantageous because if shrinkwrap is removed from the top of the container to gain access to the contents of the container, the shrinkwrap layer on the side does not fall from the sidewall of the container. Instead, the layer of shrinkwrap can cling to at least a portion of the tapered sidewall because it forms to, covers, and conforms to the shape of the surface discontinuity. Advantageously, securing the layer of shrinkwrap to at least a portion of the tapered sidewall can help retain a label in position against the tapered sidewall (whether adhesively affixed to the shrinkwrap or positioned between the shrinkwrap and sidewall without adhesive) and/or can allow shrinkwrap removed from the lid of the container and connected to the shrinkwrap clinging to the sidewall to be reused once the lid is put back on the container.

Ando does not disclose a surface discontinuity as required by claim 1. That is, Ando does not disclose a surface discontinuity disposed on a tapered side wall intermediate the rim and bottom of the container that helps hold shrinkwrap in position against a tapered sidewall. Moreover, Ando does not teach, motivate, or suggest such a

surface discontinuity that helps hold a layer of shrinkwrap in position against the tapered sidewall.

Ando discloses certain containers for storing and preparing instant cooking foodstuff, where the container and associated cover are completely enclosed with a heat contractible film in a substantially air-tight manner. (See, Ando at col. 1, lines 11-14; col. 2, lines 1-5, 22-24, and 21-40; col. 3, lines 2-8; and Figure 1 (reference character 7)). The heat contractible film is retained against the container disclosed in the Ando reference because the film completely encloses the container (i.e., bottom and side) and cover.

According to the Final O.A., Ando discloses a container that includes a portion “D” that corresponds to a surface discontinuity of the present invention. (See, page 2, numbered paragraph 2).

However, it is respectfully submitted that the “D” portion of the Ando container referred to in the Final O.A. would not help hold a layer of shrinkwrap in position against a tapered sidewall of a container because the portion “D” of the Ando container progressively narrows downward. That is, if the heat contractible film surrounding the Ando container were removed from only the top portion of the container, the heat contractible film surrounding the side of the Ando container would fall from the side of the Ando container. Thus, the Ando reference does not anticipate claim 1.

In addition, the Ando reference does not motivate or suggest modifying its disclosure to provide a surface discontinuity as required by claim 1. As mentioned above, the heat contractible film disclosed in the Ando reference is retained against the container because the film completely encloses the container and container cover. According to the Ando reference, this arrangement is perfectly acceptable. Indeed, with regard to opening the contractible film, Ando merely states that “[a]t the time of cooking ... contractible film 7 is ripped open....” (See Ando at col. 3, lines 19-29). That is, there is no indication in the Ando reference that there is a desire or need to retain the heat contractible film against the sidewall of its container if the film has been torn away from the top of the container.

Based on the above, Applicant respectfully submits that claim 1 is patentable over the Ando reference. Claims 2, 6, and 7, each dependent on claim 1, are likewise patentable.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 6, and 7 on appeal, under 35 U.S.C. 102(b) as being anticipated by Ando be withdrawn.

B. Claims 1, 2, and 6-10 are patentable under 35 U.S.C. §103(a) over Ando in view of Karevaara (U.S. Patent No. 4,102,454).

According to pages 3 and 4 of the Final O.A., Karevaara is cited for disclosing the subject matter recited in dependent claims 8-10 (i.e., a surface discontinuity including an indentation, the indentation comprising a ridge extending continuously around the sidewall, and a surface discontinuity comprising a plurality of indentations, respectively). Also, according to page 4 of the Final O.A., independent claim 1 is rendered unpatentable over Ando in view of Karevaara. This rejection will first address claim 1.

As discussed above, claim 1 is patentable over the Ando reference.

The Karevaara reference fails to cure the deficiencies of the Ando reference because Karevaara fails to teach, motivate, or suggest modifying a container disclosed in the Ando reference by providing an Ando container with a surface discontinuity as required by claim 1.

Karevaara discloses a disposable drinking mug of conical shape and having projections provided on the side of the mug and having a handle lying substantially parallel to the side and which may be formed into a grip by bending it. (See, Karevaara at the Abstract and Figures 1-7). Such mugs can be placed in a dispenser from which the mugs may be withdrawn one at a time. (See, Karevaara at col. 1, lines 6-10). According to Karevaara, projections are provided on such drinking mugs to prevent undesirable tilt and friction in a conventional stack of mugs caused by handles on the mugs. (See, Karevaara at col. 1, lines 21-34).

According to the Final O.A.:

It would have been obvious to one of ordinary skill in the art to modify the relatively smooth sidewall surface of Ando ... by Karevaara, in order to facilitate separation when stacking the containers in storage or

transportation prior to filling with the food product. The motivation for this combination are surface (sic) discontinuities provide air space between containers when they are vertically stacked... This air space inhibits similarly stacked containers from sticking together when they are separated (See, the final O.A. at page 4) (underlining emphasis added).

However, Karevaara is completely silent as to a surface discontinuity disposed on a tapered side wall intermediate the rim and bottom of the container that helps hold a layer of shrinkwrap in position against the tapered sidewall, as required by claim 1. Indeed, the Karevaara reference does not even mention shrinkwrap.

In addition, it is respectfully submitted that this line of reasoning is not convincing because the Final O.A. provides no support for concluding that one skilled in the art would have incorporated such disclosure of the Karevaara reference with a container of the Ando reference, and no support for such conclusion is apparent from the Ando and/or Karevaara references. As discussed above, the Ando reference discloses certain containers for storing and preparing instant cooking foodstuff, whereas the Karevaara reference is focused on addressing the challenge imposed by handles on conventional disposable drinking mugs. Why would a person skilled in the art modify a container for storing and preparing instant cooking foodstuff, as disclosed in the Ando reference, by providing such a container with the projections on the drinking mugs disclosed in the Karevaara reference when Karevaara was addressing stacking challenges of drinking mugs caused by having handles on their sides? According to Karevaara, having the projections on drinking mugs is to prevent undesirable tilt and friction in a conventional stack of mugs caused by handles on the mugs. The containers disclosed in the Ando reference for storing and preparing instant cooking foodstuff are not drinking mugs and do not have handles and the Ando reference does not even remotely disclose handles on its containers or remotely teach, motivate, or suggest a need for such handles. Based on the disclosure of the Ando and Karevaara references, a skilled worker would have had no motivation or suggestion to modify a container disclosed in the Ando reference by providing an Ando container with the projections disclosed in the Karevaara reference.

Moreover, the Ando reference does not disclose any concerns associated with stacking its containers or even disclose that its containers are stacked.

Based on the above discussion, it is respectfully submitted that claim 1 is patentable over Ando in view of Karevaara. Claims 2 and 6-10, each dependent on claim 1, are likewise patentable.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, and 6-10 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Karevaara be withdrawn.

C. Claim 3 is patentable under 35 U.S.C. §103(a) over Ando in view of Marino, Jr. et al. (U.S. Patent No. 5,605,230) and over Ando in view of Karevaara, and further in view of Marino, Jr. et al.

According to page 5 of the Final O.A., Marino, Jr. et al. is cited for disclosing the subject matter of dependent claim 3 (i.e., “wherein said shrinkwrap layer further comprises a tear originating at a top portion thereof and extending downward along said side wall, said shrinkwrap layer being substantially separated from said lid and rim yet substantially clinging to said side wall, whereby said lid can be opened or removed yet said shrinkwrap layer clings to said side wall”).

Claim 3 is indirectly dependent on claim 1. As discussed above, claim 1 is patentable over Ando and over Ando in view of Karevaara, so this rejection will first be addressed with respect to claim 1.

The Marino, Jr. et al. reference generally relates to determining a counterfit label and tamper indication (see, e.g., col. 1, lines 6-11). The bottle 12 disclosed in the Marino, Jr. et al. reference has a top portion that extends downward into neck portion 18 which widens through shoulder portion 16 and into cylindrical base portion 14, which extends straight down to the bottom of bottle 12 (See, the Marino Jr., et al. reference at col. 2, lines 22-30, and Figure 1).

The Marino, Jr. et al. reference fails to cure the deficiencies of Ando and Ando in view of Karevaara with respect to claim 1 because the Marino, Jr. et al. reference does not teach, motivate, or suggest to modify a container disclosed in the Ando reference by

providing an Ando container with a surface discontinuity disposed on a side wall, tapering from top to bottom, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered sidewall.

Moreover, the Marino, Jr. et al. reference does not even remotely relate to a container having a side wall tapering from top to bottom, as required by the claims. Indeed, the Final O.A. relied on the Marino, Jr. et al. reference merely for disclosing that its plastic sleeve can be torn away from the cap to remove the cap, while the remainder of the sleeve is retained against the Marino, Jr. et al. bottle. (See, the Final O.A. at page 5, numbered paragraph 5).

According to paragraph 8 on page 7 of the Final O.A.:

[T]he prior claims only required a side wall that tapered from top to bottom. As noted in the previous paragraph (9), tapering can be construed to only mean smaller toward one end, Merriam-Webster Online Dictionary....

Applicant's claim 1 recites "tapering from top to bottom." It is respectfully submitted that one of skill in the art would understand this to mean narrowing from top to bottom, especially in view of Applicant's specification and Figures (see, e.g., page 5, lines 22 and 23, and FIGS. 1-4).

It is respectfully submitted that claim 1 is patentable over Ando in view of Marino, Jr. et al. and over Ando in view of Karevaara, and further in view of Marino, Jr. et al. Claim 3, dependent on claim 1, is likewise patentable.

Accordingly, it is respectfully requested that the rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Marino, Jr. et al. and over Ando in view of Karevaara, and further in view of Marino, Jr. et al. be withdrawn.

D. Claim 4 is patentable under 35 U.S.C. §103(a) over Ando in view of Gray, Jr. (U.S. Patent No. 5,489,126) and over Ando in view of Karevaara, and further in view of Gray, Jr.

According to page 5 of the Final O.A., Gray, Jr. is cited for disclosing the subject matter recited in dependent claim 4 (i.e., further comprising an adhesive-free label

disposed between said shrinkwrap layer and said container side wall, said shrinkwrap layer holding said label in place.)

Claim 4 is dependent on claim 1. As discussed above, claim 1 is patentable over Ando and over Ando in view of Karevaara, so this rejection will first be addressed with respect to claim 1.

The Gray, Jr. reference relates to particular pipe fittings having a label secured thereto with a substantially transparent plastic tube which is shrunk with heat around the pipe fitting and the label. (See, Gray, Jr. at the Abstract). For example, Figures 1 and 2 of the Gray, Jr. reference show cylindrical pipe fittings.

The Gray, Jr. reference also fails to cure the deficiencies of Ando and Ando in view of Karevaara with respect to claim 1 because the Gray reference does not teach, motivate, or suggest to modify a container disclosed in the Ando reference by providing an Ando container with a surface discontinuity disposed on a side wall, tapering from top to bottom, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered sidewall.

Moreover, the Gray, Jr. reference does not even remotely relate to a container having a side wall tapering from top to bottom or even a container, as required by the claims. Indeed, the Final O.A. relied on the Gray, Jr. reference merely for disclosing the use of adhesive-free labels. (See, the Final O.A. at pages 5 and 6, numbered paragraph 6).

It is respectfully submitted that claim 1 is patentable over Ando in view of Gray, Jr. and over Ando in view of Karevaara, and further in view of Gray, Jr. Claim 4, dependent on claim 1, is likewise patentable.

Accordingly, it is respectfully requested that the rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Gray, Jr. and over Ando in view of Karevaara, and further in view of Gray, Jr. be withdrawn.

E. Claims 4 and 5 are patentable under 35 U.S.C. § 103(a) over Ando in view of Kaufman (U.S. Patent No. 6,247,612) and over Ando in view of Karevaara, and further in view of Kaufman.

According to page 6 of the Final O.A., Kaufman is cited for disclosing the subject matter recited in dependent claims 4 and 5 (i.e., “further comprising an adhesive-free label disposed between said shrinkwrap layer and said container side wall, said shrinkwrap layer holding said label in place” and “further comprising a label adhesively affixed to the outside of said shrinkwrap layer about said side wall,” respectively).

Claims 4 and 5 are dependent on claim 1. As discussed above, claim 1 is patentable over Ando and over Ando in view of Karevaara, so this rejection will first be addressed with respect to claim 1.

The Kaufman reference generally relates to a dispensible promotional item for a vending machine (see Kaufman at, e.g., col. 1, lines 13-19). According to the Final O.A., Kaufman discloses certain adhesive-free labels disposed between a container and shrinkwrap and labels adhesively affixed to the outside of a shrinkwrap layer (see the Final O.A. at page 6, paragraph 7).

The Kaufman reference also fails to cure the deficiencies of Ando and Ando in view of Karevaara with respect to claim 1 because the Kaufman reference does not teach, motivate, or suggest to modify a container disclosed in the Ando reference by providing an Ando container with a surface discontinuity disposed on a side wall, tapering from top to bottom, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered sidewall. Moreover, the Kaufman reference does not even remotely relate to a container having a side wall that tapers from top to bottom, as required by the claims. Indeed, the Final O.A. relied on the Kaufman reference merely for disclosing certain labels. (See, the Final O.A. at pages 6 and 7, numbered paragraph 7).

It is respectfully submitted that claim 1 is patentable over Ando in view of Kaufman and over Ando in view of Karevaara, and further in view of Kaufman. Claims 4 and 5, each dependent on claim 1, are likewise patentable.

Accordingly, it is respectfully requested that the rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over Ando in view of Kaufman and over Ando in view of Karevaara, and further in view of Kaufman be withdrawn.

Note: The following arguments are in response to the rejections presented in First O.A. (see comments above in Section III, Status of Claims).

F. Claims 1 and 8-10 are novel under 35 U.S.C. §102(e) over Rashid (U.S. Pub. No. 2001/0006165).

The Rashid reference generally relates to plastic containers for holding liquids under pressure during pasteurization or other thermal treatment (see paragraph [0002]). Rashid discloses a bottle 10 having a neck portion 16 that extends downward and outward from the container top end 12 and that widens and eventually extends into body portion 20, which extends downward to the bottom or base 28 in a way that provides an even surface (see paragraphs [0019] and [0022], and FIG. 1).

According to page 3 of the First O.A., Rashid is an anticipating reference because it discloses:

A container is disclosed comprising a container 10 having a bottom, a sidewall extending upward from the bottom and terminating in a rim above threads 14. Which is designed for a lid covering the container. Surface discontinuity 22, 26 are disposed on the sidewall intermediate the rim and the container bottom.

However, the Rashid reference does not even disclose a container having a sidewall that tapers from top to bottom, as required by claim 1. Lacking such a taper, Rashid offers no motivation to develop a combination that helps to hold shrink wrap onto tapered walls of a container because Rashid has no such walls. Indeed, Rashid does not even remotely teach, motivate, or suggest a container having the combination of features recited in claim 1, including, 1) a side wall tapering from top to bottom 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at least a portion of

the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity.

Accordingly, it is respectfully submitted that claims 1 and 8-10 are patentable over the Rashid reference and requested that the rejection of these claims under 35 U.S.C. § 102(e) as being anticipated over the Rashid reference be withdrawn.

G. Claims 1, 2, and 6 are novel under 35 U.S.C. §102(b) over Erlandson (U.S. Pat. No. 4,183,441).

The Erlandson reference generally relates to containers for pressurized products, such as beverages, having a security label (see Title and col. 1, lines 5-8). In Figure 1, Erlandson discloses a container 5 that, according to the Erlandson reference, is “simply formed of two container halves 6 and 7, each of which is of a cup-shaped configuration” (see col. 1, lines 60-64). As shown in Figure 1 of Erlandson, container 5 is generally cylindrical in shape, where the upper and lower regions are roughly the same diameter and the mid region is of a smaller diameter.

According to page 3 of the First O.A., Erlandson is an anticipating reference because it discloses:

A container is disclosed having a surface discontinuity at seam 10 and further comprises a layer 14 of shrink-wrap formed to the sidewall

However, the Erlandson reference does not disclose a container having a sidewall that tapers from top to bottom, as required by claim 1. Keeping in mind that an objective of the invention is to use shrink wrap in combination with tapered containers having a surface discontinuity disposed thereon, as claimed, in a manner so that the shrink wrap stays in place under a wide range of conditions, and given that Erlandson does not involve such tapered containers, there is no motivation or suggestion to modify the container in the Erlandson reference to arrive at the claimed combination. Indeed, Erlandson does not even remotely teach, motivate, or suggest a container having the combination of features recited in claim 1, including, 1) a side wall tapering from top to bottom, 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at

least a portion of the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity.

Accordingly, it is respectfully submitted that claims 1, 2, and 6 are patentable over the Erlandson reference and requested that the rejection of these claims under 35 U.S.C. § 102(b) as being anticipated over the Erlandson reference be withdrawn.

H. Claims 1-3, 6, and 7 are novel under 35 U.S.C. §102(b) over Marino, Jr. et al. (U.S. Pat. No. 5,605,230).

According to page 4 of the First O.A., Marino, Jr. et al. is an anticipating reference because it discloses:

A container is disclosed comprising a sidewall having a surface discontinuity at neck 18 with a shrink-wrap sleeve 24 formed on the sidewall 14

However, as discussed above (Subheading "C"), independent claim 1 is patentable over the Marino, Jr. et al. reference because, e.g., the Marino, Jr. et al. reference does not teach, motivate, or suggest a surface discontinuity disposed on a side wall, tapering from top to bottom, intermediate the rim and bottom of the container, that helps hold a layer of shrinkwrap in position against the tapered sidewall, and moreover, the Marino, Jr. et al. reference does not even remotely relate to a container having a side wall tapering from top to bottom, as required by the claims. Claims 2, 3, 6, and 7, dependent on claim 1, are likewise patentable.

Accordingly, it is respectfully requested that the rejection of claims 1-3, 6 and 7 under 35 U.S.C. 102 (b) over the Marino, Jr. et al. reference be withdrawn.

I. Claim 4 is patentable under 35 U.S.C. § 103(a) over Erlandson as applied to claim 2 above, and further in view of Gray, Jr. (U.S. Pat. No. 5,489,126).

According to page 4 of the First O.A., Gray, Jr. is cited for disclosing the subject matter recited in dependent claim 4 (i.e., further comprising an adhesive-free label disposed between said shrinkwrap layer and said container side wall, said shrinkwrap layer holding said label in place.)

Claim 4 is dependent on claim 1. As discussed above (Subheading “G”), claim 1 is patentable over Erlandson, so this rejection will first be addressed with respect to claim 1.

Claim 1 is patentable over the Erlandson reference because, e.g., the Erlandson reference does not disclose a container having a side wall that tapers from top to bottom, as required by claim 1, and moreover, Erlandson does not even remotely teach, motivate, or suggest a container having the combination of features recited in claim 1, including, 1) a side wall tapering from top to bottom and 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at least a portion of the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity.

Also as discussed above (subsection “D”), the Gray, Jr. reference relates to a particular pipe fittings (cylindrical pipe fittings in FIGS. 1 and 2) having a label secured thereto with a substantially transparent plastic tube which is shrunk with heat around the pipe fitting and the label. (See, Gray, Jr. at the Abstract).

The Gray, Jr. reference fails to cure the deficiencies of the Erlandson reference with respect to claim 1 because, e.g., the Gray, Jr. reference does not disclose a container having a side wall that tapers from top to bottom, as required by claim 1, and moreover, Gray, Jr. does not even remotely teach, motivate, or suggest a container having the combination of features recited in claim 1, including, 1) a side wall tapering from top to bottom, 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at least a portion of the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity.

Because claim 1 is patentable over the Erlandson reference in view of the Gray, Jr. reference, this rejection of dependent claim 4 is avoided.

Accordingly, it is respectfully requested that the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the Erlandson reference in view of the Gray, Jr. reference be withdrawn.

J. Claim 5 is patentable under 35 U.S.C. § 103(a) over Erlandson as applied to claim 2 above, and further in view of Fillwalk et al. (U.S. Pat. No. 3,235,112).

According to page 5 of the First O.A., Fillwalk et al. is cited for disclosing the subject matter recited in dependent claim 5 (i.e., “further comprising a label adhesively affixed to the outside of said shrinkwrap layer about said side wall”).

Claim 5 is dependent on claim 1. As discussed above (subsections “G” and “I”), claim 1 is patentable over Erlandson, so this rejection will first be addressed with respect to claim 1.

The Fillwalk et al. reference relates to a container protective wrapper (see the Title). The jar type container 10 disclosed in Figure 1 of the Fillwalk reference has a side region that extends generally straight upward from the bottom, then extends into an inwardly extending shoulder portion 11 which terminates in an upwardly opening annular neck portion 12 (See col. 3, lines 3-6, and FIGS. 1 and 2).

The Fillwalk et al. reference fails to cure the deficiencies of the Erlandson reference with respect to independent claim 1 because the Fillwalk et al. reference does not disclose a container having a side wall that tapers from top to bottom, as required by claim 1, and moreover, the Fillwalk et al. reference does not even remotely teach, motivate, or suggest a container having the combination of features recited in claim 1, including, 1) a side wall tapering from top to bottom, 2) a surface discontinuity disposed on the tapered side wall intermediate the rim and bottom of the container, and 3) a layer of shrinkwrap a) formed to and clinging to at least a portion of the tapered sidewall and b) formed to, covering, and conforming to the shape of the surface discontinuity.

Because claim 1 is patentable over the Erlandson reference in view of the Fillwalk et al. reference, this rejection of dependent claim 5 is avoided.

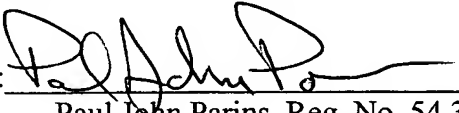
Accordingly, it is respectfully requested that the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the Erlandson reference in view of the Fillwalk et al. reference be withdrawn.

K. Conclusion

In view of these remarks, it is respectfully submitted that pending claims 1-10 are in condition for allowance.

Respectfully Submitted,

Dated: March 15, 2005

By: 
Paul John Parins, Reg. No. 54,358
Customer Number 33072
Phone: 651-275-9831
Fax: 651-351-2954

#17553

VIII. Appendix – Claims on Appeal

1. (previously presented) A container for storing items, comprising:
 - a container bottom;
 - a side wall extending upward from said bottom and terminating in a rim defining the periphery of said container, said side wall tapering from top to bottom;
 - a lid covering said container;
 - a surface discontinuity disposed on said side wall intermediate said rim and said container bottom; and
 - a layer of shrinkwrap, wherein said layer of shrinkwrap is formed to and clings to at least a portion of said tapered side wall, wherein said layer of shrinkwrap is formed to and covers said surface discontinuity and conforms to the shape thereof.
2. (previously presented) The container of claim 1, wherein said layer of shrinkwrap is formed to at least a portion of said lid.
3. (original) The container of claim 2, wherein said shrinkwrap layer further comprises a tear originating at a top portion thereof and extending downward along said side wall, said shrinkwrap layer being substantially separated from said lid and rim yet substantially clinging to said side wall, whereby said lid can be opened or removed yet said shrinkwrap layer clings to said side wall.
4. (previously presented) The container of claim 1, further comprising an adhesive-free label disposed between said shrinkwrap layer and said container side wall, said shrinkwrap layer holding said label in place.
5. (previously presented) The container of claim 1, further comprising a label adhesively affixed to the outside of said shrinkwrap layer about said side wall.
6. (original) The container of claim 2, wherein said shrinkwrap layer comprises an integral piece of shrink wrap.

7. (original) The container of claim 2, wherein said shrinkwrap layer covers the outer periphery of said lid.

8. (original) The container of claim 1, wherein said surface discontinuity comprises an indentation.

9. (original) The container of claim 8, wherein said indentation comprises a ridge extending continuously around said container side wall.

10. (original) The container of claim 1, wherein said surface discontinuity comprises a plurality of indentations disposed on said side wall.

11. (withdrawn) The container of claim 1, wherein said surface discontinuity comprises a protuberance disposed on said side wall.

12. (withdrawn) The container of claim 1, wherein said surface discontinuity comprises a plurality of protuberances disposed on said side wall.

13-16. (canceled)

IX. Appendix - Evidence

There is no evidence to be included in Appendix IX.

X. Appendix - Related Proceedings

As indicated in Section II, there are no related appeals or interferences.